REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

Rejections

Rejection Under 35USC § 102

Claims 1-20 and 22-33 have been rejected under 35 USC §102(b), as being anticipated by U.S. patent 5,323,292 to Barrett et al. ("Barrett"). Applicants respectfully traverse the rejection and request reconsideration based on features in the claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under §102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.Q. 385.* The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).* The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).* The elements must be arranged as required by the claim. *In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).*

The rejection of independent claim 1, and its dependent claims 2-16, is respectfully traversed for at least the following reasons. Claim 1 recites:

"1. (Original) A method for electronically monitoring the contents of a print job generated from print data, comprising:

analyzing the print data to build statistical information about content within the print data; and

categorizing the print job using the statistical information according to pre-specified categorization criteria."

The Office states that the Barrett reference teaches all elements of claim 1. The total rationale provided in the Office Action for the rejection of claim 1 is as follows:

"Regarding claim 1, Barrett et al discloses in column 14, lines 29-49: 'A method for electronically monitoring the contents of a print job generated from print data comprising, analyzing the print data to build statistical information about content within the print data, and categorizing the print job using the statistical information according to pre-specified categorization criteria.' Using the broadest reasonable interpretation the status and control information, which are described as monitoring features, would be pre-specified categorization criteria." (Office Action, p.2)

Applicant respectfully believes that this rejection is inadequate to establish a prima facie case of anticipation because it is merely conclusory. The majority of this rejection is a verbatim repetition of the claim language. The Office provides only one sentence purporting to explain the pertinence of the Barrett reference:

"Using the broadest reasonable interpretation the status and control information, which are described as monitoring features, would be pre-specified categorization criteria." (Office Action, p.2)

No further explanation or rationale for the rejection is provided. The Office does not point out which features in the Barrett reference correspond to specific limitations (such as, for example, "print data", "analyzing the print data", "building statistical information about content within print data", and "categorizing the print job using the statistical information") of claim 1.

37 C.F.R. §1.104(c)(2) requires that the features in the references that allegedly correspond to the limitations of the claims be pointed out with specificity. This section states:

"[T]he examiner must cite the best references at his or her command. When a reference is complex or shows or describes other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

The Barrett reference does not disclose all the essential elements of the claim, and in as complete detail as recited in the claim. The Barrett reference discloses "a method and apparatus for obtaining or for altering the status of an interactive network board or for obtaining and altering the status of a peripheral connected to the interactive network board via a peripheral interface" (col. 2, lines 17-22). This allows for "controlling the same functions of a networked printer that can be manually selected from the front panel of the printer, but remotely through an interactive network board connectable to the printer" (Abstract). In this regard,

"a Customized PCONSOLE ("CPCONSOL" ...) utility provides extensions to Novell's PCONSOLE printer utility to enable access to the powerful control and monitoring features of the open-architecture printer 4. For example, the following are typical status control information available to the network from the printer through the use of CPCONSOL: (A) status and control information such as online/offline, no response, time/date/time zone, language, offsets, error skip settings, timer, buzzer enable, toner low, paper full, paper counter, count since last service, paper out, paper jam; (B) font information such as primary, secondary, graphic set, scaling, rotation, elite; (C) layout information such as page orientation, line pitch, character pitch; (D) quality and common environment information such as number of copies, overlay, job complete, command mode, default paper size, current paper'size; and (E) configuration information such as interface, buffer size, feeder select, duplex print, page stack order, etc.

... Additionally, logs can be kept of print job flow, print engine usage, and network behavior. Examples of such usage and statistical log entries include: (A) network group information such as receive statistics, transmit statistics, and non-media related information; (B) job entry information such as date/time/time zone, log-in (user's name), job name, pages, copy count, and print status; (C) initialization entry information; (D) error condition entry information; (E) clear log entry information; and (F) printer group information such as the number of jobs, pages/job, pages/minute, time/Job, total pages/day, total jobs/day, number of days and total resets." (col. 14, line 27 – col. 15, line 2; emphasis added).

It can be seen from the above-quoted section that the status and control information of the Barrett reference there is no analysis performed on the print data to build statistical information about content within the print data, as recited in claim 1. The status and control information of the Barrett reference is related to settings of the printer, or status of the print engine and/or

network, not to the print data of the print job sent to the printer. Characteristics such as number of jobs, pages/job, etc. are not obtained by analysis of the print data content of the print job, but rather by simply monitoring the printer status. Nor is the print job categorized using the statistical information according to pre-specified categorization criteria, as recited in claim 1. With regard to statistics, the Barrett reference discloses:

"The log file includes values for the statistics which are divided into three categories: Daily, Cumulative, and Average. Daily shows the values for the current day. Cumulative shows the totals for all days since last reset, or since power-on for a printer without a disk drive. Average is the cumulative totals divided by the number of days since the last reset. For each of the three categories, the NEB maintains totals for the following values (unless CPINIT has set the logging level to "NONE"): days (number of days since a reset was issued or since power-on), pages printed, print jobs processed, off-line time, and printing time." (emphasis added)

Such an operation is not categorizing the print job, but rather categorizing the statistics themselves.

The novel features of the present invention are not anticipated by the Barrett reference in that essential elements of claim 1, recited in as complete detail as in the claim, are absent from the Barrett reference. Therefore, the rejection is improper at least for these reasons and should be withdrawn. In addition, because the present Office Action does not satisfy the requirements of 37 C.F.R. §1.104(c)(2) for the reasons stated above, Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a subsequent non-final Office Action if any of the claims are not found to be allowable.

The rejection of independent claim 17, and its dependent claims 18-20 and 22, is respectfully traversed for at least the following reasons. Claim 17 recites:

"17. (Original) A system for managing printing operations on a computer, comprising:
a statistical module that collects drawing commands and collapses the collected drawing commands into pre-determined classifications; and

a filtering module coupled to the statistical module that filters the pre-determined classifications using pre specified category criteria and categorizes the print job into at least one predefined print job category."

With regard to the Barrett reference, the Office Action states that

"the interactive board, which is used to gather status information, would be a module that collects drawing commands and groups them into pre-determined classifications. Further, the Job Pipe subsystem with its input and out put pipe segments and its filters would be a method whereby a module filters predetermined classifications." (Office Action, p.7)

Applicants respectfully disagree. There is no disclosure in the Barrett reference that the interactive board collects drawing commands and collapses the collected drawing commands into pre-determined classifications, as recited in claim 17. The interactive board (NEB 2 of Fig. 3) interfaces a printer 4 to a LAN 6 through a SCSI interface 100. As such, "[b]locks of print image data and control information are assembled by the microprocessor 216 for transmission to the printer 4" (col. 10, lines 43-45). In addition to serving as the conduit through which print data is transferred from the LAN to the printer, the interactive board includes network administration and management features which provide

"printer control and status monitoring from a remote location on the network, (i.e., from the network administrator's office), automatic management of printer configuration after each print job to provide a guaranteed initial environment for the next user, and logs of printer usage statistics accessible across the network for characterizing printer workload and scheduling toner cartridge replacement. ... [T]he ability to access the printer control state from the NEB 2 through a hi-directional interface ... allows the printer console information to be exported to the NEB or to an external network node for the programming of many useful printing support functions." (col. 9, lines 44-59)

Significantly, however, there is no disclosure in the Barnett reference that the blocks of print image data of the print job are analyzed by the interactive board, and more specifically there is no disclosure that any module of the interactive board collects drawing commands and collapses the collected drawing commands into pre-determined classifications, as recited in claim 17.

With regard to the Job Pipe subsystem of the printer 4, the Barrett reference discloses:

"The Job Pipe subsystem has a Pipe driver segment (the application for an emulator) and

input and output segments. The input and output pipe segments have at least two other segments: for input, source and source filter segments; and for output, an output filter and a data sink. The input segment of the Communication subsystem delivers the input data which can be supplemented by information from a file system. The Pipe driver processes input and supplemental data. It also generates imaging commands and page layout information that it sends to the output segment. ... The output segment sends this data to the Page Layout and Raster subsystem." (col. 8, lines 51-64)

However, there is no disclosure in the Barnett reference that its filter segments filter pre-determined classifications using pre specified category criteria and categorize the print job into at least one predefined print job category. No such categorization of print jobs occurs in the Barnett reference.

The novel features of the present invention are not anticipated by the Barrett reference in that essential elements of claim 17, recited in as complete detail as in the claim, are absent from the Barrett reference. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Independent claims 27 and 33 each recite limitations similar to those of claim 17, discussed above, and were rejected on the same basis as claim 17. For similar reasons as explained heretofore with regard to claim 17, the novel features of the present invention are not anticipated by the Barrett reference. Therefore, the rejection of independent claims 27 and 33 is improper at least for these reasons and should be withdrawn.

The rejection of independent claim 23, and its dependent claims 24-26, is respectfully traversed for at least the following reasons. Claim 23 recites:

"23. (Original) In a system for electronically monitoring the contents of a print job generated from print data, a computer-readable medium having computer-executable instructions for performing a process on a computer, the process comprising:

statistically analyzing the print data to form object type percentages using drawing command information;

classifying the print job using the statistical analysis and according to pre-specified categorization criteria; and

storing the classification in a log file and using the classification from the log file for examination and for building, enhancing and verifying future classification matches."

Applicants respectfully believe that this rejection is inadequate to establish a prima facie case of anticipation because it is merely conclusory. The rejection is a verbatim repetition of the claim language, along with the statement that "[w]ith respect to claim 23, Barrett el al discloses the methods and devices discussed above and further discloses in column 14, lines 37-68 continuing through column 15, lines 1-11" (Office Action, p.9). The basis for rejecting claim 23 is not clear and gives the Applicants little if any substantive basis for responding. As discussed above with regard to claim 1, 37 C.F.R. §1.104(c)(2) requires that the features in the references that allegedly correspond to the limitations of the claims be pointed out with specificity.

For similar reasons as discussed above with regard to claim 1, the Barrett reference performs no statistical analysis of the print data. Furthermore, there is no disclosure in the Barrett reference of forming object type percentages, nor of forming these percentages using drawing command information. Also for similar reasons as discussed above with regard to claim 1, the Barrett reference does not disclose classifying the print job using a statistical analysis and according to pre-specified categorization criteria.

The novel features of the present invention are not anticipated by the Barrett reference in that essential elements of claim 23, recited in as complete detail as in the claim, are absent from the Barrett reference. Therefore, the rejection is improper at least for these reasons and should be withdrawn, and if these claims are not held to be allowable, clarification of the rejections with respect to specific references and specific reference teachings pursuant to 37 C.F.R. §1.104(c)(2) should be provided in a non-final Office Action.

The rejection of independent claim 28, and its dependent claims 29-32, is respectfully traversed for at least the following reasons. Claim 28 recites:

"28. (Original) A printing system working in a computer environment, comprising:

an application program that generates print data for a print job;

a printer that receives the print data for printing the print jobs;

a software printer driver coupled to the printer and application program for analyzing the print data to build statistical information about content within the print data; and

a filter module coupled to the software printer driver for categorizing the print job using the statistical information according to pre-specified categorization criteria."

With regard to the Barrett reference, the Office Action states:

"Using the broadest reasonable interpretation the print job data being sent of the SCSI interface would be an application that generates print jobs. Further the various components such as the drivers, analytical techniques and statistical information, and categorization have already been disclosed above." (Office Action, p.10)

Applicants disagree with the Office's conclusion that analytical techniques and statistical information and categorization discussed earlier in the Office Action disclose the limitations of claim 28. For similar reasons as discussed above with regard to claim 1, the Barrett reference does not disclose analyzing print data to build statistical information about content within the print data, nor does it disclose categorizing the print job using the statistical information according to pre-specified categorization criteria.

The novel features of the present invention are not anticipated by the Barrett reference in that essential elements of claim 28, recited in as complete detail as in the claim, are absent from the Barrett reference. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Formalities

Allowable Subject Matter

Claims 21, 34, and 35 have been objected to as being dependent upon a rejected base claim and have been indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicants defer a decision on rewriting these claims in independent form until a future time. Applicants agree with the Office's

conclusion regarding patentability, without necessarily agreeing with or acquiescing in the reasons set forth in the Office Action. In particular, applicants wish to emphasize that the patentability of claims stems from the respective combinations of elements defined by the claims, each viewed as a whole, rather than the presence of any particular elements in the combinations. Applicants submit that the indicated claims are allowable because the prior art fails to anticipate, teach, suggest, or render obvious the invention as claimed, independent of how the invention is paraphrased. Applicants thus rely on the claims, as drafted, rather than any characterization in the Office Action.

Conclusion

Attorney for Applicant(s) has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

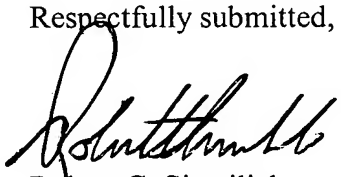
Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

AUTHORIZATION TO PAY AND PETITION

FOR THE ACCEPTANCE OF ANY NECESSARY FEES

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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